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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,485	01/19/2005	Christian Schahl	PF020090	2230
24498	7590	06/30/2006	EXAMINER	
THOMSON LICENSING INC. PATENT OPERATIONS PO BOX 5312 PRINCETON, NJ 08543-5312			TSAI, CAROL S W	
			ART UNIT	PAPER NUMBER
			2857	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/521,485

Applicant(s)

SCHAHL ET AL.

Examiner

Carol S. Tsai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/16/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to because of the following informalities:

In claim2, line, "Method according to claim 2" should read - -Method according to claim 1 - -.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Publication 2003/0066893 to Yap et al.

Yap et al. disclose method for testing an appliance (set top box (STB) 601 shown on Fig. 6(b)) having a smart card reader (remote reader 1 shown on Fig. 6(a)) for operation with a smart card by (smart card 10 shown on Fig. 6(a))) by using a test adapter (see paragraphs 0022 and 0024) being inserted into the smart card reader (see paragraphs 0022 and 0024) for testing of the appliance, the test adapter having contacts (contacts 7 shown on Fig. 6(a)) being used as an interface to the smart card reader (see paragraph 0179-0186), and using a contact of the smart card reader as a serial interface for testing of the appliance , which is not used by the appliance

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during operation with a smart card (see paragraph 0184), wherein one of the smart card contacts used for testing of the appliance is the smart card contact for the programming voltage VPP (see paragraphs 184), said contact being used as an input for transmit signals in accordance with a RS 232 serial port(see paragraph 0349).

As to claim 2, Yap et al. also disclose the test adapter is coupled via a cable (communications cable 3 shown on Fig. 6(a)) to a computer (computer 100 shown on Fig. 6(a)), and that as a further smart card contact (contact 7 shown on Fig. 6(a)) for testing of the appliance a contact for data in/out (see paragraph 0185) is used, for operation of the test adapter as a serial interface in connection with the computer (see Fig. 6(a)).

As to claim 3, Yap et al. also disclose the appliance being a digital set-top box (set top box (STB) 601 shown on Fig. 6(b)) or a digital satellite receiver and the method for testing of the appliance being a Factory Functional Test or an aftersales diagnostics test (see paragraph 0348).

As to claims 4 and 5, Yap et al. disclose appliance with a smart card reader (remote reader 1 shown on Fig. 6(b)) for an operation with a smart card (smart card 10 shown on Fig. 6(b)), wherein one contact of the smart card reader (see paragraph 0184), which is not used by the appliance during normal operation with a smart card, is being used as a serial port for testing of the appliance (see paragraph 0184).

As to claim 6, Yap et al. also disclose the contacts used for testing of the appliance are a supply voltage input (see paragraph 0179), the programming voltage VPP (see paragraph 0184), a data In/Out contact (see paragraph 0185) and ground (see paragraph 0186).

As to claim 7, Yap et al. also disclose the contact for data In/Out is coupled to a

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buffer circuit, and after amplification by the buffer circuit is coupled to a DIN contact (DIN) as well as to a receive contact of a RS232 internal interface (see paragraph 0660).

As to claim 9, Yap et al. also disclose a Factory Functional Test or an aftersales diagnostics test (see paragraph 0348).

Allowable Subject Matter

4. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol S. W. Tsai whose telephone number is (571) 272-2224. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (571) 272-2216. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).

cswt

June 23, 2006

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CAROL S.W. TSAI
PRIMARY EXAMINER